

7/Reconsideration
By
5/2/02

Patent
Attorney's Docket No. 033355-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
)	
Manitolo E. ADAN et al.)	Group Art Unit: 2778
)	
Application No.: 09/998,305)	Examiner: M. Said
)	
Filed: December 3, 2001)	
)	
For: INPUT DEVICE WITH)	
FORWARD/BACKWARD)	
CONTROL)	



REQUEST FOR RECONSIDERATION
AND
REQUEST FOR INTERFERENCE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Official Action of February 27, 2002, please consider the following requests.

Initially, applicants' representatives express their appreciation for the courtesies granted during the personal interview conducted March 27, 2002. During the interview, the differences between the applied prior art and that of the subject matter recited by claims 30-33 were discussed. Additionally, the requirements and procedures for establishing an interference with U.S. Patent No. 6,198,473 to Armstrong were also discussed.

REQUEST FOR RECONSIDERATION

The following paragraphs relate to a request to reconsider the grounds for rejection set forth in the Official Action of February 27, 2002.

As correctly noted in the Office Action Summary, claims 30-33 are pending and await further consideration on the merits. Upon entry of the present response, claims 30-33 remain pending and await further consideration on the merits.

Claims 30-33 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,828,364 to Siddiqui (hereafter "*Siddiqui*") in view of U.S. Patent No. 5,854,624 to Grant (hereafter "*Grant*") on the grounds set forth in paragraph 2 of the Official Action. For at least the reasons noted below, the rejection should be withdrawn.

The present claimed invention is directed to a computer mouse having forward and/or backward control functionality that is not dependent upon the cursor location of a computing device. The presently claimed invention is also directed to a method of using a computer mouse which includes the step of activating a button to send a page-back signal regardless of the cursor position on the display.

Claims 30-33 are set forth in the attached Appendix B.

Neither *Siddiqui* nor *Grant*, taken alone or in combination, would have suggested the subject matter of claims 30-33.

Siddiqui discloses a computer mouse having a one-piece case top and an integrated switch. However, *Siddiqui* is devoid of any disclosure concerning the forward and/or backward functionality of the device. This deficiency is acknowledged in paragraph 2 of the Official Action:

Siddiqui does not expressly teach that the network browsing software receiving the page back message without requiring the mouse cursor to be located on a back button of the network browsing software display on the monitor.

The teachings of *Grant* are relied upon in order to satisfy this deficiency. However, *Grant* teaches an entirely new and different piece of hardware, in the form of a "pocket-sized user interface" used for internet browser terminals. Nowhere does *Grant* disclose, or even suggest, that the recited forward and/or back functionality, which is not dependent upon cursor location on the monitor, can be provided within a mouse.

To the contrary, *Grant* suggests that a completely new and separate piece of hardware is necessary in order to accomplish this objective. Thus, one of ordinary skill in the art would not have been motivated to modify the mouse disclosed by *Siddiqui* in order to provide the recited forward and/or backward functionality.

Thus, to reiterate, neither reference recognizes or teaches providing a mouse with back/forward functionality, much less providing such functionality regardless of cursor position.

Therefore, the rejection is improper and should be withdrawn.

Additionally, as explained in detail in the following request for interference, claims 30-33 are not patentably distinct from certain claims contained in U.S. Patent No. 6,198,473 to *Armstrong* (see, e.g. - Appendix B). Thus, any prior art rejections which could arguably be made to claims 30-33 of the present application would also be applicable to the *Armstrong* patent. As set forth in MPEP §2307.02:

If the ground of rejection is also applicable to the corresponding claims in the patent, any letter including the rejection must have the approval of the TC Director.
(Emphasis added.)

REQUEST FOR INTERFERENCE

The following paragraphs relate to the Request to declare an Interference.

I. Identification of interfering patent

Through presentation of claims 30-33, it is expected that an interference involving the present application to Adan et al. (hereafter "*Adan*") and U.S. Patent No. 6,198,473 to Armstrong (hereafter "*Armstrong*") (of record) will be declared. The face of the *Armstrong* patent indicates that it is unassigned. However, the prosecution history of *Armstrong* reveals that the application may be assigned to "Anascape", a Nevada limited partnership.

The patent to *Armstrong* issued on March 6, 2001, from an application filed on October 6, 1998. The *Armstrong* patent does not contain any priority claim.

II. Presentation of proposed count

Applicants set forth a proposed count in "Appendix A" which is believed to be an appropriate count for purposes of the interference.

Applicants' proposed count is an alternative recitation of *Armstrong* patent claims 16, 18, 20 and 22 and the *Adan* application claims 30, 31, 32 and 33, respectively. An alternative count is being proposed, in part, due to the differences in terminology utilized by the respective parties, yet describing the same invention.

III. Identification of *Armstrong* patent claims that correspond to the count

The *Armstrong* patent includes 28 claims. Claims 16-28 should be designated as corresponding to applicants' proposed count. These claims define subject matter that is not separately patentable from the subject matter of applicants' proposed count.

Claim 16 of *Armstrong* is identical to the first alternative recitation of the proposed count. Thus, claim 16 corresponds exactly to the proposed count.

Claim 17 is dependent upon claim 16. Claim 17 further recites a second user depressible surface for communicating a second command signal to the computer, the second command signal being dedicated to moving the network browser software to a forward address. Claim 17 is not separately patentable from the count since claim 17 would have been obvious over the proposed count at least in view of U.S. Patent No. 5,854,624 to Grant (hereafter "*Grant*") (of record), once one of ordinary skill in the art would have been provided with the teachings of the proposed count. *Grant* suggests providing a second surface for sending a command signal to the computer dedicated to moving browser software to a forward address (see, e.g. - column 5, lines 31-48).

Claim 18 of *Armstrong* is identical to the third alternative recitation of the proposed count. Thus, claim 18 corresponds exactly to the proposed count.

Claim 19 is dependent upon claim 18. Claim 19 further recites inclusion of a forward button, whereby depression of the forward button causes reception of a forward control signal by browsing software initiating the software to display a previously viewed network address, without a requirement of the pointer being located on the software forward button displayed on the monitor. Claim 19 is not separately patentable from the

count since claim 19 would have been obvious over the proposed count at least in view of *Grant* once one of ordinary skill in the art would have been provided with the teachings of the proposed count. *Grant* suggests providing a forward button for executing a forward control signal to display a previously viewed network address, regardless of whether the pointer is located on the software forward button (see, e.g. - column 1, line 60 through column 2, line 3 and column 5, lines 31-48).

Claim 20 of *Armstrong* is identical to the fifth alternative recitation of the proposed count. Thus, claim 20 corresponds exactly to the proposed count.

Claim 21 is dependent upon claim 20. Claim 21 further recites the step of activating one of the buttons to send a forward signal, regardless of the cursor position on the display, to network navigating software. Claim 21 is not separately patentable from the count since claim 21 would have been obvious over the proposed count at least in view of *Grant* once one of ordinary skill in the art would have been provided with the teachings of the proposed count. *Grant* suggests activating a button to send a forward signal, regardless of the cursor position on the display to navigating software (see, e.g. - column 1, line 60 through column 2, line 3 and column 5, lines 31-48).

Claim 22 of *Armstrong* is identical to the seventh alternative recitation of the proposed count. Thus, claim 22 corresponds exactly to the proposed count.

Claim 23 is dependent upon claim 22. Claim 23 further recites the step of depressing one of the buttons to send a signal, regardless of the cursor position on the display, to network browsing or navigating software for commanding display of a most recent previously viewed address. Claim 23 is not separately patentable from the count

since claim 23 would have been obvious over the proposed count at least in view of *Grant* once one of ordinary skill in the art would have been provided with the teachings of the proposed count. *Grant* suggests the step of depressing a button to cause network browsing or navigating software to command the display of a most recent previously visited address regardless of cursor position on a display (see, e.g. - column 1, line 60 through column 2, line 3 and column 5, lines 31-48).

Claim 24 is dependent upon claim 16. Claim 24 further recites that the network navigation software navigates the internet. Claim 24 is not separately patentable from the count since application of navigation software to navigate the internet would have clearly been obvious to one having ordinary skill in the art, particularly after one of ordinary skill in the art would have been provided with the teachings of the proposed count. *Grant* suggests the application of pre-programmed control signals associated with user-activated buttons as being especially applicable for internet navigation software (see, e.g. - column 3, lines 1-4).

Claim 25 is dependent upon claim 16. Claim 25 further recites that the computer has a display, and that the mouse further includes a cursor controller for communicating cursor command signals to the computer, the cursor command signals instructing the computer to move a cursor on the display, said first command signal causing the network navigation software to move to the previously visited network address regardless of a current location of the cursor on the display. Claim 25 is not separately patentable from the count since claim 25 would have been obvious over the proposed count once one of ordinary skill in the art would have been provided with the teachings of the proposed count.

One of ordinary skill in the art would clearly have provided a display and a mouse with a cursor controller for interfacing with the user and for communicating cursor command signals to the computer. Moreover, *Grant* suggests generating a command signal causing network navigation software to move to the previously visited network address regardless of current location of the cursor on the display (see, e.g. - column 1, line 60 through column 2, line 3 and column 5, lines 31-48).

Claim 26 is dependent upon claim 16. Claim 26 further recites that the user depressible surface is located on a side of the housing. Claim 26 is not separately patentable from the count since claim 26 would have been obvious over the proposed count at least in view of U.S. Patent No. 5,657,051 to Liao (hereafter "*Liao*") (of record), since *Liao* clearly suggests providing a user depressible surface, or button, on a side of a mouse for user convenience, etc. (see, e.g. - column 4, lines 1-9).

Claim 27 is dependent upon claim 17. Claim 27 further recites that the user depressible surfaces are located on a side of said housing. Claim 27 is not separately patentable from the count since claim 27 would have been obvious over the proposed count at least in view of *Grant* (as set forth above in connection with claim 17) and *Liao*, since *Liao* further suggests providing a user depressible surface or button on a side of a mouse for user convenience, etc. (see, e.g. - column 4, lines 1-9).

Claim 28 is dependent upon claim 17. Claim 28 further recites that the network navigation software navigates the internet. Claim 28 is not separately patentable from the count since claim 28 would have been obvious over the proposed count at least in view of *Grant* (as discussed above in connection with claim 17), and further in view of the fact that

Grant clearly suggests association of command signals with user depressible buttons or surfaces for navigation functions to be executed in internet navigation software (see, e.g. - column 3, lines 1-4).

IV. Applying the terms of Applicants' claims 30-33

At least for the purpose of satisfying the requirements of 37 C.F.R. §1.607(a), applicants provide the attached Appendix B which includes an element-by-element recitation of *Armstrong* claims 16, 18, 20 and 22, as compared to *Adan* claims 30-33. "Appendix B" further contains exemplary disclosure contained in the present *Adan* disclosure which supports claims 30-33.¹

V. Identification of *Armstrong* claims that do not correspond to the proposed count

Claims 1-15 are directed to subject matter involving pressure sensitive switch constructions and methods for control of scrolling speed. This subject matter is not comprehended by the proposed count. Thus, claims 1-15 of *Armstrong* do not correspond to the proposed count.

VI. Identification of Applicants' claims that correspond to the count

As noted above, the proposed count is an alternative count which includes, verbatim, the language of claims 30-33. More particularly, the second alternative recitation

¹ Applicants have set forth exemplary support in Appendix B, but reserve the right to identify and demonstrate additional support if necessary or desirable.

of the proposed count corresponds exactly to claim 30. The fourth alternative recitation of the proposed count corresponds exactly to claim 31. The sixth alternative recitation of the proposed count corresponds exactly to claim 32. The eighth alternative recitation of the proposed count corresponds exactly to claim 33.

VII. Claims 30-33 are patentable to the Applicants

Claims 30-33 were first presented for consideration by the Preliminary Amendment filed concurrently herewith. Claims 30-33 contain all the material limitations of claims 16, 18, 20 and 22 of *Armstrong*, respectively. Moreover, the present *Adan* application has an earlier effective filing date than the *Armstrong* patent. Therefore, Applicants expect that the Patent Office will consider claims 30-33 to be patentable over the prior art, just as claims 16, 18, 20 and 22 of *Armstrong* were considered to be patentable over the prior art.

VIII. *Adan* should be designated as the Senior Party

The present application of *Adan* having Serial No. 09/153,148, was filed SEPTEMBER 14, 1998.

To constitute a constructive reduction to practice of the proposed count, an application need only disclose one species within the scope of the count. See, e.g.- *Mori v. Costain*, 214 USPQ 295,297 (BPAI 1981). The above-identified application discloses at least one species within the scope of the count. Thus, there is a constructive reduction to practice of the invention of *Adan* corresponding to the filing date of SEPTEMBER 14, 1998.

By contrast, the earliest possible effective filing date, and thus the earliest possible constructive reduction to practice, which could be arguably be afforded to *Armstrong*, is the filing date of application Serial No. 09/167,314, filed OCTOBER 6, 1998.

Therefore, even if one were to assume that *Armstrong* is entitled to claim a constructive reduction to practice of OCTOBER 6, 1998, *Adan's* constructive reduction to practice clearly precedes this date (i.e. - SEPTEMBER 14, 1998).

IX. Conclusion

Applicants respectfully request that an interference be declared between the present application and U.S. Patent No. 6,198,473 employing the proposed count set forth in Appendix A, and designating claims 30-33 of the present application to *Adan*, as well as claims 16-28 of *Armstrong*, as corresponding to the count. Applicants further request that *Adan* be designated as the Senior Party in the interference.

Respectfully submitted,

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